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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,280	05/24/2001	Tsuyoshi Yamane	2001_0642A	9243

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EXAMINER

FULLER, ERIC B

ART UNIT PAPER NUMBER

1762

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,280

Applicant(s)

YAMANE, TSUYOSHI

Examiner

Eric B Fuller

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-19 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-19 and 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-9, 15 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Gross et al. (US 5,658,616).

Gross teaches a process where two or more aqueous paints, having different colors, are sprayed onto a substrate and the overspray of both colors is washed off with water and recycled in a single collection unit (column 2, lines 30-55). Because the different colors are collected together and remixed in proportions such that the original colors are achieved for reuse (column 2, lines 1-27), the original colors must be based on the same pigments. Ultrafiltration is used to separate the paint from the water to make a concentrate that is then mixed with fresh paint, color matched, and reused (column 2, lines 55-65; column 4, lines 1-30). The time that exists between concentrating the paint and mixing the concentrate with fresh paint reads on storing the paint.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al. (US 5,658,616), as applied to claims 7 and 15 above, and further in view of Saatweber et al. (US 5,453,301).

Gross teaches the limitations of claims 7 and 15, as shown above, but is silent to a circulation water bath. However, Saatweber teaches using a circulating water bath in paint booths in order to collect overspray from the walls of the paint booth (abstract). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the circulating water bath taught by Saatweber in the process taught by Gross. By doing so, one would reap the benefits of collecting the overspray that acquires on the walls of the spray booth.

Claims 21, 22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al. (US 5,658,616), as applied to claim 7, and further in view of Hayahara et al. (US 4,913,198).

Gross teaches the limitations of claim 7, as shown above, but is silent to using computer-color-matching equipment. However, Hayahara teaches that computer-color-matching devices are well known in the art as a rapid and easy method to analyze and control coloring of paints (column 1, lines 14-40). It would have been obvious at the

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time the invention was made to a person having ordinary skill in the art to use a computer-color-matching device when reusing the overspray (combining with fresh paint) or producing fresh paint, as taught by Gross. By doing so, the color of the paint is easily and rapidly controlled.

Claims 11-13, 18, 19, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al. (US 5,658,616) and Saatweber et al. (US 5,453,301), as applied to claims 10 and 17, and further in view of Hayahara et al. (US 4,913,198).

Gross, in view of Saatweber, teaches the limitations of claims 10 and 17, as shown above, but is silent to using computer-color-matching equipment. However, Hayahara teaches that computer-color-matching devices are well known in the art as a rapid and easy method to analyze and control coloring of paints (column 1, lines 14-40). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a computer-color-matching device when reusing the overspray (combining with fresh paint) or producing fresh paint, as taught by Gross. By doing so, the color of the paint is easily and rapidly controlled.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al. (US 5,658,616) and Saatweber et al. (US 5,453,301), as applied to claim 10, and further in view of Spangler (US 5,684,053).

Gross, in view of Saatweber, teaches the limitations of claims 10 and 17, as shown above, but fails to explicitly teach washing the paint booth when changing colors

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that are based on different pigment combinations. However, Spangler teaches that when two or more types of paints are used, the collected overspray is segregated by color and type (column 2, lines 60-64) and separated into condensed paint and filtrate by use of ultra filtration (column 4, lines 59-67). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to segregate the collected paints by color and type when the different colors are based on different pigment combinations. By doing so, one would have a reasonable expectation of success, as the negative effects of mixing unlike paints would be avoided. Since the water-curtains read on washing the spray booth, the filtrate being recycled reads on the limitations to claim 14.

Response to Arguments

Applicant argues that Gross fails to teach collecting excess aqueous paints having different colors based on the same combination of pigments. In support, the applicant alleges that Gross is not concerned with the amount of facilities and equipment necessary. This is not found convincing. Gross explicitly teaches spraying different colors and collecting these colors in a single coating unit (column 1, lines 1-15). The paint that is sprayed is a mixture of the condensed excess paint that was collected and fresh paint. Because the sprayed paint of differing colors all comprise the condensed excess paint, which in turn comprises a mixture of the different colors that were collected, the different colors that are sprayed must have the same pigments. Thus reading on "based on the same combination of pigments". Additionally, Gross

explicitly teaches that a benefit of the invention is the reduction in equipment, as only one coating unit is required even though different colors are used.

It is further noted that the claims still lack a clear limitation that reads to collect different colors that have the same pigments together in one unit while collecting colors that having different pigments in separate units, grouped such that each unit collects different colors that all have the same pigments. According to the interview with the Attorney of record, this appears to be the essence of the invention.

Conclusion

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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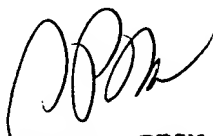
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B Fuller whose telephone number is (571) 272-1420. The examiner can normally be reached on Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck, can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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